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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/612,456
Filing Date: July 02, 2003
Appellant(s): CHEN, YEN-FU

Chen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/13/07 appealing from the Office action mailed 7/16/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2004/0073868	Easter et al.	4-2004
6,882,981	Philippe	4-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 7, 8-11, 14, 15-18, 21, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Easter US Publication 2004/0073868.

As per claim 1, Easter teaches a method in a data processing system for presenting input fields from a document, the method comprising:

Parsing the document to identify a selected indicator associated with a set of mandatory input fields in the document; (see Easter, paragraph 0124) and

Presenting only the set of mandatory input fields. (see Easter, paragraph 0124; Since each field's visibility is controlled, the users can set non-mandatory fields to invisible)

As per claim 2, Easter teaches the method of claim 1. Easter further teaches wherein the presenting step comprises display the set of mandatory input fields in a window. (see Easter; paragraph 0085; Figure 27)

As per claim 3, Easter teaches the method of claim 1. Easter further teaches wherein the presenting step comprises:

Reformatting the document to contain only the set of mandatory input fields. (see Easter, paragraph 0124; Since each field's visibility is controlled, the users can set non-mandatory fields to invisible)

As per claim 4, Easter teaches the method of claim 1. Easter further teaches wherein the presenting step comprises:

Presenting a first input field from the set of mandatory input fields; (see Easter; paragraph 0043) and

Responsive to information being entered in the first input field, presenting a second input field from the set of mandatory input fields. (see Easter; paragraph 0043; the event, which second field becomes required or optional instead of read-only, is presenting a second input)

As per claim 7, Easter teaches the method of claim 1. Easter further teaches the method comprising:

Determining whether any of the set of mandatory input fields correspond to pre-stored information; (see Easter; paragraph 0038); and

Responsive to an input field within the set of mandatory input fields corresponding to pre-stored information, filling the input field within the set of mandatory input fields with the pre-stored information. (see Easter; paragraph 0038; Automatic population of items is filling the input field)

As per claims 8-11 and 14; 15-18 and 21; they are rejected with same rationale as claim 1-4 and 7. Supra.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 6, 12, 13, 19, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Easter US Publication 2004/0073868 in view of Philippe; US Patent 6,882,981

As per claim 5, Easter teaches the method of claim 1. However, Easter fails to teach the indicator is a hypertext markup language tag.

Philippe teaches the indicator is a hypertext markup language tag. (see Philippe; column 5, lines 20-40)

It would have been obvious to an artisan at the time of the invention to include Philippe's teaching with method of Easter in order to allow users to fill out the application over the internet.

As per claim 6, Easter and Philippe teach the method of claim 5. Philippe further teaches the document is a web page. (see Philippe; column 5, lines 20-40)

As per claims 12 and 13, and 20; they are rejected with the same rationale as claim 5 and 6. Supra.

As per claim 22, it is of the same scope as claim 5. Supra.

(10) Response to Argument

A: Ground of rejection (Claims 1-4, 7, 8-11, 14, 15-18, 21, and 22)

1) Whether Easter teaches "parsing the document to identify a selected indicator associated with a set of mandatory input fields?"

1) Easter teach "parsing the document to identify a selected indicator associated with a set of mandatory input fields," because Easter's program allows users to parsing through a pre-existing form and identifies the mandatory fields (see Easter, paragraph 0124) and Easter's program also parses through the user modified form to perform a compliance check. (see Easter, paragraph 0053.) During both parsing processes, the mandatory input fields are identified. In the user parsing process, the user would analyze each item on the document and determine which item is required and which item is not. (see Easter, paragraph 0124) Furthermore, Easter's program would perform a compliance check, which would require it to parsing through the user modified document and identified which input field is mandatory. (see Easter, paragraph 0053; 0039) Therefore, Easter teaches this limitation.

2) Whether Easter teaches "presenting only the set of mandatory input field?"

2) Easter teaches presenting only the set of mandatory input field, because Easter provides users with the ability to control the visibility of each field based on whether each field is optional or required. (see Easter, paragraph 0124)

3) Whether Easter teaches "reformatting the document to contain only the set of mandatory input fields?"

3) Easter teaches presenting reformatting the document to contain only the set of mandatory input fields because Easter provides users with the ability to control the visibility of each field based on whether each field is optional or required (see Easter, paragraph 0124) and therefore the form can be reformatted to display only the mandatory input fields.

B: Ground of rejection 2 (Claim 5, 6, 12, 13, 19, and 20)

1) Whether Philippe teach "the indicator is a hypertext markup language tag?"

1) Philippe teaches identifying indicator based on hypertext markup language tags because it parses through webpage form (see Philippe; column 8, lines 4-10) based on the identifiers on the forms that include identifier for URL, identifier for form name, and identifier for relationship. (see Philippe; column 7, lines 55-70) These identifiers are hypertext markup language tag.

2) Whether there exists a proper reason for combining the references.

2) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Philippe provides a motivation, which is to improve users' online browsing experience when they have to fill out an online form. (see Philippe, column 2, lines 35-40; column 2, lines 65-70)

Furthermore, the Supreme Court has stated that the Federal Circuit had erred when it applied the well-known teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way. Specifically, as the Supreme Court pointed out, the Federal Circuit had erred in four ways:

- (1) "by holding that courts and Patent examiners should look only to the problem the patentee was trying to solve;"
- (2) by assuming "that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem;"
- (3) by concluding "that a patent claim cannot be proved obvious merely by showing that the combination of elements was 'obvious to try,'" and
- (4) by overemphasizing "the risk of court and patent examiners falling prey to hindsight bias" and as a result applying "rigid preventative rules that deny fact finders recourse to common sense." KSR, 82 USPQ2d at 1397.

In the present case, the combination of Philippe and Easter is obvious to one of ordinary skill in the art because it allow user to modify a HTML based form.

(11) Related Proceeding(s) Appendix

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Peng Ke

/Peng Ke/

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